

Remarks

Applicants respectfully request confirmation of the status of the claims since the Office Action Summary Form PTOL-326 of page 1 of the Office Action shows allowed claims which is inconsistent with the rejections set forth on pages 2-3 of the Office Action.

Claim 1, as amended, describes an imaging head capable of imaging a section of the stressed skin tissue from light returned from focused light under the surface of the skin tissue. This is not new matter as it is supported in the specification, in which “under the surface of skin tissue” is supported at page 2, line 6, “imaging a section” is supported at page 7, lines 12-13, page 9, lines 15-16, and page 11, lines 4-6, “focusing” is supported in the specification by the presence of an objective lens for imaging (see page 5, lines 21-22, page 8, line 23, and page 10, lines 14-15). Further, this amendment is also supported by the incorporated by reference U.S. Patent Application No. 08/650,684. Entry of the amendment in Claim 1 and the similar amendment in Claim 35 is requested.

Claims 1, 2, 8, 19, and 26-37 were rejected as being anticipated by U.S. Patent No. 5,146,923 (Dhawan). This rejection is traversed on the grounds that Dhawan is not capable of providing the imaging of amended Claim 1. Dhawan describes a nevoscope which uses a still or video camera (9) to record images of tissue (see column 7, lines 8-10). A still or video camera cannot provide an image of a section through tissue from light returned from focused light under the tissue surface, but rather provides an image of the tissue surface, or an image of a volume of tissue transilluminated from the surface to a depth.

Claim 26 describes imaging stressed tissue from light returned from a scanned focal spot through the tissue to provide an image of a section. Dhawan describes a nevoscope having a still or video camera (9) which has no capability of scanning a focal spot through tissue. Dhawan at best can image a tissue surface, or an image of a volume of tissue transilluminated from the surface to a depth, which is not comparable to an image of a section through tissue. Thus, Claims 1 and 26, and any dependent claims thereupon, are not anticipated by Dhawan.

With respect to Claim 19, Dhawan shows no optical elements for confocal imaging, but only a still or video camera. Still or digital cameras cannot enable confocal imaging which optically sections tissue. Thus, Claim 19 cannot be anticipated by Dhawan.

For reasons argued with respect to Claim 1, Claim 35 and its dependent Claims 36-37 are also not anticipated by Dhawan. Withdrawal of the rejection of Claims 1, 2, 8, 19 and 26-37 is respectfully requested.

Claims 3, 20, and 23 were rejected as being unpatentable over Dhawan in view of the Jester et al. article "In Vivo, Real-time Control Imaging" in the Journal of Electron Microscopy Techniques, Vol. 18, No. 1 (1991). With respect to Dhawan, Claim 3 depends on base Claim 1, which for reasons argued earlier is patentable over Dhawan. Also, Dhawan fails to show the first and second moving means of Claim 20, and the translating means of Claim 23. One skilled in the art would not combine Dhawan and Jester et al. Dhawan relates to a handheld portable nevoscope which receives a raised tissue specimen in its inverted cup housing (44) (see Abstract, FIG. 1, and column 7, lines 54-55 of Dhawan). Connecting the Dhawan nevoscope to the x,y,z table of Jester et al. (see FIG. 2 of Jester et al.) would obviate Dhawan both being handheld and portable (see, Abstract lines 2-3 of Dhawan). Moreover, no need is present for a x,y,z table in Dhawan since a specimen in Dhawan's nevoscope is positionally oriented in the nevoscope by virtue of the specimen's placement in the inverted cup housing (44), as clearly evident by FIG. 1 of Dhawan. Therefore, Dhawan already provides by its design proper alignment to tissue and thus no motivation for adding alignment by an x,y,z table of Jester et al. is present, especially where it prevents Dhawan from being portable as taught by Dhawan. One skilled in the art would not add an element which obviates the teaching of a design. Moreover, Jester et al. fails to show the platen of Claims 3, 20 and 23 having an orifice for stabilizing tissue. Thus, Claims 3, 20 and 23 are believed patentable over Dhawan and Jester et al., either alone or in combination, and withdrawal of their rejection is requested.

Claim 6 was rejected as being unpatentable over Dhawan. Claim 6 depends on base Claim 1, which for reasons argued earlier is patentable over Dhawan. Dhawan further lacks the Claim 6 means for translating an imaging head. Mere insertion of a video or still camera (9) in an eyepiece (10) of Dhawan is not comparable to translating an imaging head, as contended by the Examiner's statement "Dhawan discloses means for moving the imaging head with respect to the orifice in that the camera can be inserted into the device" (page 3, lines 21-23, of the Office Action). In other words, Claim 1 describes the imaging head coupled to the maintaining means to provide an integrated assembly. Before camera (9) is inserted in the eyepiece (10) of the Dhawan nevoscope housing (28) no integrated assembly with such housing (28) is present, since it is separate from the housing (28) (see FIG. 1 of Dhawan). Thus, at the time the Examiner contends such translating could occur in Dhawan Claim 1 is not met, and once the camera (9) is inserted in the eyepiece (10) Dhawan does not describe or suggest movement of the camera. Thus, Applicant requests that the rejection of Claim 6 be withdrawn.

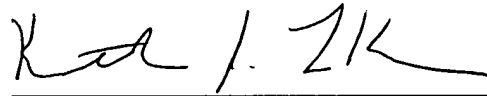
Claims 4, 5, 7, 21, and 22 are allowable but objected to as being dependent on rejected claims. Claims 4 and 7 have been rewritten in independent form with limitations of their respective intervening claims and base Claim 1. Claim 5 depends on allowable Claim 4. Applicants believe that dependent Claims 21 and 22 are allowable along with their base Claim 20.

Non-elected Claims 38-41 are cancelled pending their possible filing in a divisional application, while Claims 42-46 are added to the present application.

A terminal disclaimer over U.S. Patent No. 6,424,852 is enclosed to overcome the double patenting rejection with a check for the terminal disclaimer fee.

A petition for a three-month extension of time is enclosed with a check for the required petition fee.

Respectfully submitted,



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Enclosures: Combined Amendment Transmittal and Petition for Extension of Time with a  
Check for \$475.00;  
Terminal Disclaimer with a check for \$55.00;  
Certificate of Mailing by Express Mail, Express Mail No. EV 325176681 US.